

REMARKS

This responds to the Office Action mailed on September 13, 2007.

Claims 1, 12, 23, and 34 are amended, claims 3, 14, 25, and 36 are canceled; as a result, claims 1-2, 4-13, 15-24, 26-35, and 37-48 are now pending in this application.

§103 Rejection of the Claims

Claims 1, 3-5, 9-12, 14-16, 20-23, 25-27, 31-34, 36-38 and 42-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan et al. (U.S. 5,966,685; hereinafter “Flanagan”) in view of Gastaldo et al. (U.S. 6,473,729; hereinafter “Gastaldo”).

Applicable Law

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See M.P.E.P. §2142*. In the recent decision of the Supreme Court on *KSR Int'l Co. v. Teleflex Inc.*¹, the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*², was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.”³

When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn*⁴. In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of*

¹ 127 S.Ct. 1727, 82 USPQ.2d 1385 (2007).

² 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

³ The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

⁴ 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

*Kansas City*⁵. Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*⁶. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*⁷. Office personnel must rely on the applicant's disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*⁸.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took.⁹ In addition, the references when combined must teach or suggest all the claim elements.¹⁰

Applicant believes that the issue of patentability of independent claims 1, 12, 23, and 34 (as amended) over Flanagan in view of Gastaldo is best understood with regard to claim 1.

Claim 1 includes the following limitations:

"communicating a plurality of predetermined language constructs to a first entity as a first transmission over said network; retrieving entity information relating to a second entity based on an identifier of said second entity selected by said first entity; responsive to receipt of a selection by said first entity of a language construct of said plurality of predetermined language constructs, identifying a translated language construct corresponding to said selected language construct, said identifying based on the entity information relating to the second entity and said selected language construct; and communicating said translated language construct to said second entity as a second transmission over said network, said selected language construct is a predetermined question that is asked by said first entity, said translated language construct is a translation of said predetermined

⁵ 383 U.S. 1 at 467.

⁶ 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁷ 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

⁸ 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S., 116 S. Ct. 1384 (1996).

⁹ *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994)

¹⁰ *In re Vaech*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991).

question that is identified responsive to receipt of said selection by said first entity.”

Applicant respectfully submits that the above limitations of claim 1 are not taught or suggested by the following language from Flanagan as alleged in the Office Action:

“The present invention is a system of parallel discussion groups operated in conjunction with a message collection posting software program, data filter software program, and a machine translation software program. The present invention comprises a number of discussion groups running in “parallel”; one group for each language being used in the discussion groups. The individual discussion groups all contain the same information, in the same order; the only difference being that each parallel discussion group is written in a different language.”¹¹

Flanagan relates to a system that allows for an electronic discussion group user to communicate with another user who speaks a different language. The Office Action alleges that “said identifying based on entity information relating to a second entity and said selected language construct” is taught by the following language of Flanagan:

“Upon logging onto discussion group, the user may choose his or her language preference. All translation is performed at the network site so no other actions on the part of the user are required to take advantage of the present invention. For example, a French user may log onto a discussion group and access the French version of the system”

The Office Action maintains that Flanagan discloses “identifying based on entity information” as required by claim 1 because the language selected in Flanagan depends on the discussion group accessed by a user. Applicant respectfully disagrees because the “identifying of a translated language construct corresponding to said selected language construct … based on the entity information” is not taught or suggested by a description of logging into a language-specific version of a discussion group.. Nonetheless, Applicant is herein amending claim 1 clarify the meaning of “identifying of a translated language construct corresponding to said selected language construct … based on the entity information” by preceding the element with

¹¹ Flanagan, Col 2 Lines 21-30

“retrieving entity information relating to a second entity based on an identifier of said second entity.”

As admitted by the Office Action, Flanagan does not “communicate a plurality of predetermined language constructs to a first entity” as required by claim 1. The Office Action alleges that Gastaldo teaches what Flanagan lacks to render claim 1 obvious. Gastaldo relates to a method for translating an input text from a natural source language to a natural target language. The Office Action alleges that Gastaldo teaches “communicating a plurality of predetermined constructs to a first entity.” Even assuming, arguendo, that Gastaldo teaches or suggests “communicating a plurality of predetermined constructs to a first entity” as alleged in the Office Action, Gastaldo still fails to teach or suggest “identifying of a translated language construct corresponding to said selected language construct … based on the entity information” as argued above with respect to Flanagan.

In summary, Flanagan, whether considered separately or in combination with Gastaldo, fails to teach or suggest each and every limitation of claims 1, 12, 23, and 34 as is required to support a *prime facie* case of obviousness in rejecting of the independent claims of the present application under 35 U.S.C. § 103.

Further, a person reasonably skilled in the art would be taught away from combining Flanagan and Gastaldo. Flanagan provides an example of a known translation method that may be utilized to perform translations:

“a translation may be performed by direct translation of the text (e.g. direct French to English translation). The words in sentences then looked up in electronic dictionaries to identify their translations. The translated words are then reordered and inflected according to the rules of the target language.”¹²

Applicant respectfully submits that the method of translation illustrated in Flanagan teaches away from combination of Flanagan and Gastaldo. As stated in the background of the present application, direct word for word translation is imperfect and produces grammatically incorrect sentences in the translated language. Claim 1 requires “responsive to receipt of a selection by said first entity of a language construct of said plurality of predetermined language

¹² Flanagan, Col 5 Lines 8-14

constructs, identifying a translated language construct corresponding to said selected language construct" which is not the "direct translation of the text" identified in Flanagan as a preferred translation method.

Claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan in view of Gastaldo and further in view of Scanlan (U.S. 6,857,022). Claims 8, 19, 30 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan in view of Gastaldo and further in view of Christy (U.S. 6,301,554).

Applicant has carefully studied Scanlan and Christy but could not find any subject matter that could be added to the combination of Flanagan and Gastaldo to render independent claim 1 obvious. Accordingly, neither Scanland nor Christy can provide the elements of claim 1 that Flanagan and Gastaldo lack. The above remarks are also applicable to a consideration of amended independent claims 12, 23, and 34, which are each distinguished from the proposed combination of Flanagan and Gastaldo for the same reasons as claim 1.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and it follows, from the above remarks, that claims 2, 6-8, 13, 17-19, 24, 28-30, 35, 39-41 and 46-48 are also nonobvious under 35 U.S.C. §103(a).

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official

Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 13th day of December 2007.

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Signature